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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,711	01/27/2004	W. James Jackson	2479.0040003/BJH/C-K	4900
78/078      7590      09/05/2008 Sterne, Kessler, Goldstein & Fox, P.L.L.C. 1100 New York Avenue, NW Washington, DC 20005				
EXAMINER BASKAR, PADMAVATHI				
ART UNIT		PAPER NUMBER		
1645				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/766,711

**Applicant(s)**

JACKSON ET AL.

**Examiner**

Padma V. Baskar

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 83-132 is/are pending in the application.
- 4a) Of the above claim(s) 87-90, 93-96, 112-115, 118-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83-86, 91, 92, 97-111, 116, 117 and 122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The after final amendment filed on 7/29/08 is acknowledged and has been entered. Upon further review of the application and claims, the finality of the previous Office action is withdrawn.

***Status of Claims***

2. Claims 1-82 have been canceled.  
Claims 83-132 are pending .  
Claims 83-86, 91-92, 97-111, 116-117 and 122-132 are under examination with respect to elected SEQ.ID.NO:2.  
Claims 87-90, 93-96, 112-115, 118-121 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention (i.e., SEQ.ID.NOS: 15, 16, 23 and 24).

***Claim Rejections under 35 U.S.C. 112 withdrawn***

3. The Declaration submitted by Dr James Jackson under 37 CFR 1.132 filed 7/29/08 is sufficient to overcome the rejection of claim 83-86, 91-92, 97-111, 116-117 and 122-132 under 35 U.S.C. 112, first paragraph.

***Claim Rejections under 35 U.S.C. 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 86 and 99 are rejected under 35 U.S.C. 112, first paragraph, as failing to provide an enabling disclosure without complete evidence that the claimed biological materials are

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known and readily available to the public or complete evidence of the deposit of biological materials.

The specification lacks complete deposit information for the deposit of the plasmid pJJ 36-J having ATTC Accession No. PTA-3719 and plasmid pAH342 obtainable from *E. coli* BL21 (pAH342) assigned ATCC accession number 98538.

It is not clear that the plasmid pJJ 36-J is known and publicly available or can be reproducibly isolated from nature without undue experimentation. Because one skilled in the art could not be assured of the ability to practice the invention as claimed in the absence of the availability of the plasmid pJJ 36-J and plasmid pAH342 obtainable from *E. coli* BL21 (pAH342) assigned ATCC accession number 98538 of the invention, a suitable deposit for patent purposes, evidence of public availability of the plasmid pJJ 36-J of the invention or evidence of the reproducibility without undue experimentation of the monoclonal antibodies is required.

If the deposit has been made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicant or assignees or a statement by an attorney of record who has authority and control over the conditions of deposit over his or her signature and registration number stating that the deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon public access to the deposit will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository is required. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves this specific matter to the discretion of each State. Amendment of the specification to recite the date of deposit and the complete name and full street address of the depository is required. As a possible means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit.

If the deposits have not been made under the provisions of the Budapest Treaty, then in order to certify that the deposits comply with the criteria set forth in 37 CFR 1.801-1.809, assurances regarding availability and permanency of deposits are required. Such assurance may be in the form of an affidavit or declaration by applicants or assignees or in the form of a

statement by an attorney of record who has the authority and control over the conditions of deposit over his or her signature and registration number averring:

(a) during the pendency of this application, access to the deposits will be afforded to the Commissioner upon request;

(b) all restrictions upon the availability to the public of the deposited biological material will be irrevocably removed upon the granting of a patent on this application;

(c) the deposits will be maintained in a public depository for a period of at least thirty years from the date of deposit or for the enforceable life of the patent of or for a period of five years after the date of the most recent request for the furnishing of a sample of the deposited biological material, whichever is longest; and

(d) the deposits will be replaced if they should become nonviable or non-replicable.

In addition, a deposit of biological material that is capable of self-replication either directly or indirectly must be viable at the time of deposit and during the term of deposit. Viability may be tested by the depository. The test must conclude only that the deposited material is capable of reproduction. A viability statement for each deposit of a biological material not made under the Budapest Treaty must be filed in the application and must contain:

- 1) The name and address of the depository;
- 2) The name and address of the depositor;
- 3) The date of deposit;
- 4) The identity of the deposit and the accession number given by the depository;
- 5) The date of the viability test;
- 6) The procedures used to obtain a sample if the test is not done by the depository; and
- 7) A statement that the deposit is capable of reproduction.

As a possible means for completing the record, applicant may submit a copy of the contract with the depository for deposit and maintenance of each deposit. If the deposit was made after the effective filing date of the application for patent in the United States, a verified statement is required from a person in a position to corroborate that the plasmid pJJ 36-J and plasmid pAH342 obtainable from *E. coli* BL21 (pAH342) assigned ATCC accession number 98538 described in the specification as filed is the same as that deposited in the depository. Corroboration may take the form of a showing of a chain of custody from applicant to the depository coupled with corroboration that the deposit is identical to the

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biological material described in the specification and in the applicant's possession at the time the application was filed.

Applicant's attention is directed to In re Lundack, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR 1.801-1.809 for further information concerning deposit practice.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 83-86, 91-92, 97-111, 116-117 and 122-132 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of 243-250 and 253-266 copending Application No.08/942,596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are drawn to a pharmaceutical composition comprising an amino acid sequence at least 95% identical to amino acids 29-533 of SEQ.ID.NO:2 or 29-1012 of SEQ.ID.NO:2 or SEQ.ID.NO:2 where as the claims of copending application are drawn to an isolated polypeptide comprising an amino acid sequence at least 95% identical to amino acids 29-533 of SEQ.ID.NO:2 or 29-1012 of SEQ.ID.NO:2 or SEQ.ID.NO:2. Thus the present claims are anticipated by the copending application claims since the composition of the present claims comprises the polypeptide of copending application.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

8. No claims are allowed.

9. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m except First Friday of each bi-week. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon can be reached on (571) 272-0898.

/ Padma Baskar /  
Examiner 1645

/Shanon A. Foley/

Supervisory Patent Examiner, Art Unit 1645